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Response to Office Action Dated 07/28/2005

REMARKS

As background information, this Response is submitted in response to the Office Action of 07/28/2005. Claims 1—19 were originally filed. No claims have been added, withdrawn or cancelled. Claims 9, 16 and 18 are currently amended. Accordingly, claims 1—19 are currently pending. At this time, all claims are rejected. In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the rejected claims.

35 U.S.C. §102 Rejections

Applicant submits that the Office has failed to establish a *prima facie* case of anticipation and respectfully traverses the Office's rejections. However, before discussing the substance of the Office's rejections, a section entitled "The §102 Standard" is provided and will be used in addressing the Office's rejections. Following this section, a section entitled "The Kageyama Reference" is provided, which describes Kageyama's disclosure.

The §102 Standard

According to the MPEP §2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim.

Anticipation is a legal term of art. The applicant notes that in order to provide a valid finding of anticipation, several conditions must be met: (i) the reference must include every element of the claim within the four corners of the reference (see MPEP §2121); (ii) the elements must be set forth as they are recited in the claim (see MPEP §2131); (iii) the teachings of the reference cannot be

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modified (see MPEP §706.02, stating that "No question of obviousness is present" in conjunction with anticipation); and (iv) the reference must enable the invention as recited in the claim (see MPEP §2121.01). Additionally, (v) these conditions must be simultaneously satisfied.

5 The §102 rejection of claims 1—6 is believed to be in error. Specifically, the PTO and Federal Circuit provide that §102 anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The corollary of this rule is that the absence from a cited
10 §102 reference of any claimed element negates the anticipation. *Kloster Speedsteel AB, et al. v. Crucible, Inc., et al.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

 The applicant notes the requirements of MPEP §2131, which states "to anticipate a claim, the reference must teach every element of the claim."
15 This MPEP section further states that "'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). 'The identical invention must be shown in as complete
20 detail as is contained in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."

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The Kageyama Reference

Kageyama notes that documents may be stored in a printer for re-use, re-printing and/or re-editing (Kageyama, 0005). Kageyama addresses problems encountered when a user wants to edit a document that is resident
5 in a printer. The problems are related to document format, in that a 'dot image' or 'image' format is more efficient for the printer, but causes degradation when edited (Kageyama, first 11 lines of 0006).

Thus, Kageyama addresses the problem of deterioration of quality resulting from editing of documents stored in a printer (see 0006, lines 7—
10 11). Accordingly, Kageyama discloses a system and method configured to extract a document stored in a printer for editing of the document by means of an application program (0008 references the problem of 0007).

However, document format issues exist—i.e. without a 'match' (0007, line 5) between the application program and the format of the document
15 stored in the printer, there is insufficient compatibility to perform the editing. Accordingly, Kageyama discloses checking to see if the format of a document stored in a printer is the format required by a display/editing application program on a computer (Kageyama, 0026). If they are the same, the document stored on the printer is moved to the computer, without
20 modification, for editing and/or display (Kageyama, 0027). If the formats are different, then the document on the printer is converted into a document of the required display/editing format (Kageyama, 0028). Once edited, the document can be returned to the printer.

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Traversal of the §102 Rejections

Claims 1—6 were rejected under §102 as being anticipated by U.S. Patent Application No. US 2004/0017583, hereinafter “Kageyama.” In response, the Applicant respectfully traverses the rejection.

5

Claim 1 recites a method for operating a printer, comprising:

- writing a document to a file;
- translating the file, using a procedure, into a sequence of commands for a page description language; and
- 10 • sending the page description language commands to a page description language interpreter.

Kageyama discloses translating a file *into a format required for editing and/or displaying the content* (Kageyama, 0222). In particular, 0222 of Kageyama
15 discloses:

“This document format conversion section 2700 is directed to convert the documents of storage format stored in the archive 2200 into documents of display/ editing format.”

20

Thus, Kageyama specifically discloses translating from a storage format to a display/editing format. In contrast, the Applicant recited translating “translating the file, using a procedure, into a sequence of commands for a page description language”. Thus, while Kageyama discloses, and the Applicant’s claims recite,
25 convert(ing) and “translating”, respectively, it can be seen that Kageyama does not perform the same translation, and the translation does not have the same result, as

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that recited in the Applicant's claim. That is, Kageyama converts to a display/editing format, while the claims recite translating to commands for a page description language. Thus, Kageyama does not disclose the recited elements.

Similarly, at 0223, Kageyama discloses conversion from PDL format, into a document display/editing format (emphasis added). Thus, while the Applicant recites translating the file into a sequence of commands for a page description language, Kageyama discloses translating the file from a page description language into a display and/or editing format.

The document conversion section 2700 convert documents from PDL (page description language) into a display/editing format (Kageyama, 0223). More particularly, "PDL format conversion section 2710" is configured to convert from PDL into a display/editing format (Kageyama, 0223) and "image format conversion section 2720" converts a compressed document of dot image format into an uncompressed document of dot image format (Kageyama, 0224). Accordingly, the section 2700 is not a PDL interpreter, which is a device/object that 'interprets' PDL commands (typically producing raster or dot-based image information) suitable to run a print engine within a printer.

The Patent Office suggests that the translating of the Applicant's claim is disclosed by Kageyama at 0223, wherein the section 2710 converts from PDL to a format of HTML.

The Applicant respectfully disagrees. Kageyama discloses translating *from* PDL (page description language) *into* HTML or PDF or other display/editing format (see first sentence of Kageyama's 0223). However, this is not what the Applicant recited. The Applicant recited, "translating the file, using a procedure,

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into a sequence of commands for a page description language". Thus, the Kageyama reference discloses translating from PDL, not into PDL. Thus, Kageyama reference does not disclose the elements recited by the Applicant's claim.

5 The Patent Office suggests that "sending the page description language commands to a page description language interpreter" is disclosed by Kageyama at 2710 and 2720 in Fig. 6, and at 0222 and 0223 in the text.

 The Applicant respectfully disagrees. The sections 2710 and 2720 are not a "page description language interpreter." A page description language interpreter
10 interprets the statements of the page description language, thereby creating raster (e.g. dot matrix output) to run the print engine. In contrast, sections 2710 and 2720 perform the conversion from PDL into the display/editing format. Thus, a PDL interpreter translates data into raster to run the hardware and create hardcopy output, the sections 2710/2720 translate PDL into higher level formats for editing.

15 Therefore, we have seen that Kageyama fails to disclose translating the file into a sequence of commands for a PDL, and that Kageyama fails to disclose sending the commands to a page description language interpreter. Accordingly, the Applicant respectfully requests that the section 102 rejection be removed.

20 **Claim 2** recites a method as recited in claim 1, additionally comprising:

- receiving an error message in response to an unrecognized command in the document.

 The Patent Office suggests that the failure reports of paragraph 306 disclose
25 the recited elements. However, Kageyama fails to disclose responding to "an unrecognized command in the document." In fact, Kageyama discloses that a

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failure of a file to transfer could be reported by a 'transfer completion report.' In contrast, the Applicant's claim recites a configuration able to realize that a command is unrecognized, and sends an error report. Therefore, in contrast to the Applicant's recited claim, Kageyama fails to disclose the capacity to distinguish
5 "unrecognized commands." Therefore, Kageyama does not disclose the elements recited by claim 2; accordingly, the Applicant respectfully requests that the section 102 rejection be withdrawn.

Claim 3 depends from claim 1, and is allowable by virtue of this dependence, as well as for reasons associated with the element recited therein.
10

Claim 4 recites a method as recited in claim 1, wherein:

- the procedure is written in the page description language.

The Patent Office suggests that paragraph 0297 of Kageyama discloses this
15 aspect. The Applicant respectfully disagrees. Kageyama discloses that documents can be formatted in page description language. In fact, page description language is routinely used as the formatting language of print jobs, and thereby to direct printers on how to print the information contained in documents. That is, the page description language provides the instructions needed by the printer to generate
20 the 'raster data' that results in printed output. In contrast, what the Applicant's claim recites is that a procedure, which has been written in page description language, is used to translate the incoming document into page description language. Thus, page description language is being used by the procedure, which is written in page description language, and page description language is *also*
25 being used as the format of the output of the procedure. Thus, the Applicant

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recites a novel use of page description language. While page description language was intended to format print jobs, the Applicant recites a novel use of that same language, by using that language to write a procedure to translate a file *into* page description language commands. This is advantageous, since printers already
5 know how to operate page description language. However, Kageyama does not disclose the use of page description language for any purpose other than describing pages to a printer. In particular, Kageyama does not disclose use of a procedure, written in a page description language, to translate a file into page description language. Accordingly, the Applicant respectfully requests that the
10 section 102 rejection of claim 4 be removed, and that this claim be allowed to issue.

Claim 5 depends from claim 4, and is allowable by virtue of this dependence, as well as for reasons associated with the element recited therein.

Claim 6 depends from claim 1, and is allowable by virtue of this
15 dependence, as well as for reasons associated with the element recited therein.

The §103 Rejections

The Applicant submits that the Office has failed to establish a *prima facie* case of obviousness and, in view of the comments below, respectfully traverses the Office's rejections. However, before discussing the substance of the Office's
20 rejections, a section entitled "The §103 Standard" is provided and will be used in addressing the Office's rejections.

The §103 Standard

To establish a *prima facie* case of obviousness, three basic criteria *must* be met. MPEP § 2142. First, there must be some suggestion or motivation, either in

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the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable
5 expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Hence, when patentability turns on the question of obviousness, the search
10 for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine or modify the references relied on as evidence of obviousness. The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to
15 the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed").

Traversal of the §103 Rejections

Claims 7—19 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,652,711 hereinafter "Vennekens" in view of Kageyama. In
20 response, the Applicant respectfully traverses the rejection.

Claim 7 recites a method for printing a document using a printer having an interpreter supported by a page description language comprising:

- calling an error handler in response to an unrecognized command in the document;
- 25 • writing statements prior to the unrecognized statement, to a file;

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- writing a data stream, comprising the unrecognized statement and subsequent statements in the document, to the file;
- translating the file into a sequence of page description language commands; and
- 5 • sending the page description language commands to the interpreter.

Claim 16 recites a similar translation. The Patent Office suggests that paragraph 0222 and 0223 disclose the translating. The Applicant respectfully disagrees, and incorporates by reference the argument with respect to claim 1.

10 Moreover, the Vennekens reference fails to remedy Kageyama's failure to disclose the translation, as recited by the claims. Therefore, the elements of claims 7 and 16 are not shown by the prior art. Accordingly, the Applicant respectfully requests that the rejection of claims 7 and 16 be removed, and that these claims be allowed to issue.

15 Claim 8 depends from claim 7, and is allowable by virtue of that dependence, as well as for reasons associated with the elements recited by claim 8.

Claim 9 recites, in part, "wherein the translating is performed by a procedure written in the page description language". The arguments from claim 4, above, are incorporated herein by reference. The Kageyama reference discloses

20 no procedures or subroutines that are written in page description language. Instead, Kageyama uses page description language for its convention use, i.e. as a format by which a file to be printed is written. Thus, in a conventional setting—e.g. the Kageyama reference—page description language is used to format a document containing information to be printed. In contrast, the Applicant has

25 recited in claim 9 that translating is performed by a procedure written in the page description language.

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The Patent Office points to paragraph 0297 of Kageyama. However, for at least the reasons discussed above, Kageyama does not use page description language as the language with which a procedure is written. (Kageyama uses page description language as the language for formatting files to be printed.) Moreover, Kageyama does not disclose using the procedure to “translate the file into a sequence of page description language commands” (claim 7). Accordingly, the Applicant respectfully requests that the rejection to claim 9 be removed.

Claim 10 depends from claim 7, and is allowable by virtue of that dependence, as well as for reasons associated with the elements recited by claim 10.

Claims 11 and 13 were rejected by the Patent Office in the same paragraph, based on section 103 in view of Vennekens and Kageyama. Claims 11 and 13 recite aspects of “translating,” and the argument with respect to claim 1 is incorporated herein by reference. As seen in the discussion of Claim 1, Kageyama fails to disclose the translating recited in claims 11 and 13. Accordingly, the Applicant respectfully requests that the rejection to claim 1 be removed.

Claim 12 recites, in part, “wherein the translation is performed by a procedure written in the page description language.” The Patent Office cites paragraph 0100 as an example of translation being performed by a procedure written in page description language.

The Applicant respectfully disagrees. In fact, paragraph 0100 discloses how a file is written to a spool, including some information on the format and data written with the file. No translation is disclosed. The arguments from claims 4 and 9, above, are incorporated herein by reference. The Applicant points out that

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claim 12 recites translation performed "by a procedure written in the page description language." As noted above, this means that the procedure that does the translating is actually written in page description language, which is the language in which the files to be printed are also written. This is a novel situation, and is certainly not disclosed by the Kageyama. Accordingly, the Applicant respectfully requests that the rejection of claim 12 be removed, and that claim 12 be allowed to issue.

Claim 14 depends from claim 13, and is allowable by virtue of that dependence, as well as for reasons associated with the elements recited by claim 13.

Claim 15 depends from claim 13, and is allowable by virtue of that dependence, as well as for reasons associated with the elements recited by claim 15.

Claim 17 depends from claim 16, and is allowable by virtue of that dependence, as well as for reasons associated with the elements recited by claim 17.

Claim 18 recites, in part, "wherein the error handler is written in the page description language." The Patent Office cites Vennekens column 5 line 64 to column 6 lines 3 as an example of the recited material.

The arguments from claims 4, 9 and 12, above, are incorporated herein by reference.

Vennekens discloses how page description language coming in can be translated into raster data by a plurality of parallel processors. In the cited paragraph, Vennekens discloses that error handling is present. However,

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Vennekens does not disclose an error handler that is written in page description language. Instead, Vennekens uses PDL for what everyone else uses PDL for, that is, a language by which files to be printed may be written. Vennekens does not disclose writing an error handler in the same language that is used to write documents to be printed. Accordingly, the Applicant respectfully requests that the rejection of claim 18 be removed, and that claim 18 be allowed to issue.

Claim 19 depends from claim 16, and is allowable by virtue of that dependence, as well as for reasons associated with the elements recited by claim 19.

Conclusion

The Applicant submits that all of the claims are in condition for allowance and respectfully requests issuance of a Notice of Allowability. If the Office's next anticipated action is not the issuance of a Notice of Allowability, the Applicant respectfully requests scheduling of an interview with the undersigned attorney.

Respectfully Submitted,

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